

Appln. No. 09/944,009  
Amendment dated July 10, 2003  
Reply to Office Action mailed 5/21/03

**REMARKS**

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 3, 4, 7 through 17, and 20 through 25 remain in this application. Claim 9 has been cancelled in this Response, and claims 2, 5, 6, and 18 through 19 have previously been cancelled. No claims have been withdrawn. No claims have been added in this Response.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

**Paragraphs 2 and 3 of the Office Action**

Claims 1 and 25 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The use of the term "substantially" in claim 1 has been objected to as rendering the claim indefinite, and MPEP §2173.05 (d) was cited as the basis for this objection. As that section of the MPEP deals with "Exemplary Claim Language", it is believed that MPEP §2173.05(b) (subsection D) may have been intended as this section deals with "Relative Terminology" and particularly the term "substantially". It is noted that MPEP §2173.05(b) (subsection D) states that the term "substantially" is often used in claims, and only gives examples of where the term was determined to be "definite". The Examiner's attention is drawn particularly to the description of the language used in the third case cited in the subsection, as the term "substantially" was used to modify "equal" in this case. It is submitted that the use of the term "substantially uniform" is similar to "substantially equal", and would be understood by those one of ordinary skill in the art. It

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is also submitted that the term "uniform" is generally understood as meaning "not varying" (similar to the meaning of "equal" as being "identical" or "equivalent").

Further, it is submitted that one of ordinary skill in the art, considering the applicant's disclosure (and especially the drawings), would understand what is meant by "substantially equal", and therefore this terminology as used in the claims is definite under the requirements of 35 USC §112.

The above amendment to claim 25 is believed to clarify the requirements of the rejected claim, especially with respect to the particular point identified in the Office Action.

Withdrawal of the §112 rejection of claims 1 and 25 is therefore respectfully requested.

**Paragraphs 4 through 7, 9, and 10 of the Office Action**

Claims 1, 4, 11, 14, 20 through 21 and 23 have been rejected under 35 U.S.C. §102(b) as being anticipated by Doberne (USPN 3,602,419).

Claims 7 and 12 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of York (USPN 4,030,654).

Claims 10 and 22 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Steigauf (USPN 4,519,536).

Claim 13 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Doberne (USPN 3,602,419) as applied to claim 1 above, and further in view of Dudek (USPN 3,734,515).

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Claim 1 requires, in part, "wherein the channel of the guide bushing has a substantially uniform diameter along a length of the guide bushing".

The Doberne reference teaches a nail driver that includes sleeve members 18 and 19. The Office Action alleges that "Examiner disagrees due to Doberne's illustration of a guide bushing having a uniform diameter at the upper portion of the guide bushing, as well as the lower portion of the guide bushing". Thus, it appears that the position in the Office Action is that because the upper portion of the bore in sleeve member 18 is uniform and the diameter of the lower portion of the bore of sleeve member 18 is uniform, that the Doberne reference teaches the above quoted requirement of claim 1 even though the requirement states that the "substantially uniform diameter" extends along the length of the guide bushing.

It is submitted that one of ordinary skill in the art would not consider the diameter of the bore through the sleeve member 18 of Doberne to be substantially uniform along the length of the sleeve member 18. Specifically, Doberne discloses in the drawings that the diameter upper portion of the bore of sleeve member 18 is at least four times greater than the diameter of the lower portion of the bore of sleeve member 18. And this is not merely a quirk in the drawings, as the upper portion of the bore of sleeve 18 is sized to accept a portion or section of the spring 31, while the lower portion of the bore of sleeve member 18 must be smaller to form a shoulder for the spring 31 to bear against to bias the sleeve member 18 outward. Clearly, the intervening shoulder between the upper portion of the bore and the lower portion of the bore of the sleeve member 18 of Doberne must not be uniform so as to form the shoulder against which the spring must be able to bear.

It is therefore submitted that the Doberne teaching would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claim 1, especially with the requirements set forth above, and therefore it is

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submitted that claim 1 is allowable over the prior art. Further, claims 4, 7, 10 through 14, and 20 through 23 depend from claim 1 and thus also include the requirements discussed above, are therefore also submitted to be in condition for allowance as it is submitted that no combination of Doberne with the York, Steigauf, and Dudek references would lead one of ordinary skill in the art to the claimed requirements of these dependent claims.

With respect to claim 20, which requires "the uniform diameter of the channel of the guide bushing is slightly larger than a diameter of the forward end of the drive punch", it is noted that, in addition to the remarks above, the selective partitioning of the bore of the sleeve member 18 of Doberne in the Office Action just emphasizes the fact that Doberne employs a larger diameter portion of the bore of the sleeve member to accept a section of the spring while employing a smaller diameter section of the bore of sleeve member 18 to accept the shank 27. It is submitted that these disparate functions of the bore of the sleeve member 18 just lend further credence to the fact that the diameter of the bore of Doberne is not substantially uniform along the length of the sleeve member 18.

With respect to claim 21, which requires that "the shroud and the slidable guide bushing have an overall length, a length of the slidable guide bushing comprising approximately one-third of the overall length of the shroud and guide bushing", it is noted that the Office Action attempts to define only the "forward most" portion of the sleeve member 18 as the claimed guide bushing, where previously the Office Action asserts that the entire sleeve member 18 forms the claimed guide bushing. (See, for example, the marked-up copy of the Doberne reference where the upper portion of sleeve member 18 is labeled as the claimed "guide bushing".) It is clear that in the Doberne teaching, the movable sleeve member 18 is two thirds of the overall length of the sleeve members 18 and 19 of Doberne, which is completely opposite of the claim 21 requirements.

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Withdrawal of the §102(b) rejection of claims 1, 4, 11, 14, 20 through 21 and 23 is therefore respectfully requested.

**Paragraph 8 of the Office Action**

Claims 8 and 9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Hsu (USPN 4,830,254).

The requirements of claim 9 have been incorporated into claim 8, and therefore claim 9 has been cancelled.

Claim 8 requires "wherein the muffling means comprising a muffler member mounted on the rear portion of the shroud, the muffler member having a bore in communication with the bore of the shroud, *an annular space being formed about the bore of the muffler member for extending about a barrel portion of the hammer tool* when the shroud is mounted on the hammer tool, and a muffling material for absorbing vibration *being positioned in the annular space for extending about the barrel portion* when the shroud is mounted on the hammer tool" (emphasis added). This feature of the claimed invention places the muffling material in close proximity, if not contact, with the barrel portion of the hammer tool to help minimize the transfer of vibration from the hammer tool to the invention, and vice versa.

The Hsu reference teaches a driving system in which a shield 76 extends around the exterior of the barrel 12 of the driving system, while the void identified (by the reference number 12) in the Office Action is located either in the interior of the barrel 12, or between two portion of the barrel 12 (crossed by the reference arrow in Figure 1). In either case, it is clear that the shield 76 is not positioned in the void of barrel 12, as the shield 76 is exterior to, and extends outwardly from, the exterior of the barrel 12 and the barrel end replacement 44. It is submitted that this relationship shown

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in the figures of the Hsu reference would not lead one of ordinary skill in the art to the claim 8 requirement that "a muffling material for absorbing vibration [is] positioned in the annular space for extending about the barrel portion".

Withdrawal of the §103(a) rejection of claim 8 is therefore respectfully requested.

**Paragraph 11 of the Office Action**

Claim 17 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Doberne (USPN 3,602,419) in view of Gupta (USPN 4,139,137) Steigauf (USPN 4,519,536).

It is noted that claim 17 includes substantially the same requirements as claim 3 (including claim 1) which as been indicated as being allowable over the prior art, and therefore claim 17 is submitted to be allowable over the prior art.

Withdrawal of the §103(a) rejection of claim 17 is therefore respectfully requested.

**Paragraph 13 of the Office Action**

Claims 15 through 16 and 24 have been allowed.


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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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